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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,818	06/30/2000	Jiann H. Chen	81326D-W	2410

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/608,818

Applicant(s)

CHEN ET AL.

Examiner

Elena Tsoy

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) The period for reply expires ____ months from the mailing date of the final rejection.
b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: ____.

3. Applicant's reply has overcome the following rejection(s): ____.
4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: ____.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: ____.

Claim(s) objected to: ____.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: ____.

8. The proposed drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.
10. Other: Notice of References Cited (PTO-892).

Response to Amendment

1. Amendment filed on September 10, 2002 has been entered. Claims 1-22 are pending in the application.

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2. The amendment and Request for Reconsideration filed on September 3, 2002 under 37 CFR 1.116 in reply to the final rejection have been considered but is not deemed to place the application in condition for allowance. 7.

Claims 1-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hartley et al (US 4,853,737) and incorporated by reference Lentz (US 4,257,699) in view of Schlueter, Jr. et al (US 5,995,796) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on March 5, 2002 (Paper No. 3).

Claims 1-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hartley et al (US 4,853,737) in view of Schlueter, Jr. et al (US 5,995,796) and Blong et al (US 5,549,948) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on July 17, 2002, (Paper No. 5).

Response to Arguments

3. Applicants' arguments filed August 22, 2002 have been fully considered but they are not persuasive.

(A) Applicants argue that: fluoroelastomers and fluorocarbon thermoplastic random copolymer are distinctly different materials: for example, polyfluorocarbon elastomers such as vinylidene fluoride-hexafluoropropylene copolymers have relatively high surface energies,

which compromises toner release, while fluorocarbon thermoplastics like PTFE or FEP have excellent release characteristics due to very low surface energy; and fluoroelastomers of all Hartley et al, Lentz, and Schueter, Jr. et al, in particular VITON™ elastomers, are characterized by relatively high surface energies, causing them to have less than optimum toner release properties.

The Examiner respectfully disagrees with this argument. Firstly, the features upon which applicant relies (i.e., excellent release characteristics due to very low surface energy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Secondly, fluoroelastomers of Hartley et al are **not** vinylidene fluoride (VF)-hexafluoropropylene (HFP) copolymers having relatively high surface energies, but are polymers comprising *pending* polydiorganosiloxane (silicone of very low surface energy) such as polydimethylsiloxane (See column 5, lines 13-14), the polydimethylsiloxane being a *thermoplastic* polymer, as evidenced by Vaia et al (US 6,225,374, column 2, lines 27-28, 37-40), covalently bonded to a backbone of a terpolymer of VF-HFP and PTFE (of very low surface energy), the VF-HFP-PTFE being also *thermoplastic*, as evidenced by Shifman et al (US 6,203,873, column 6, lines 38-40). Clearly, a polymer comprising a thermoplastic backbone such as thermoplastic VF-HFP-PTFE with pending thermoplastic polydimethylsiloxane chains of very low surface energy is thermoplastic and has low surface energy. In other words, fluoroelastomer of Hartley et al is in fact claimed *fluorocarbon thermoplastic random copolymer* having subunits of $-(CH_2CF_2)_x-$, $-(CF_2CF(CF_3)_y-$, $-(CF_2CF_2)_z-$, wherein $x = 61\%$, about $y = 17\%$ and $z = 22\%$.

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Therefore, combination of Hartley et al, Schlueter, Jr. et al and Blong et al clearly meets the claim 1 since Hartley et al teach an organic solvent-based coating composition *comprising* a fluorocarbon thermoplastic random copolymer, a curing agent having a bisphenol residue, a particulate filler containing a combination of metal oxides such as zinc oxide, antimony oxide, tin oxide, the fluorocarbon thermoplastic random copolymer having subunits of $-(CH_2CF_2)^x-$, $-(CF_2CF(CF_3)^y-$, $-(CF_2CF_2)^z-$, wherein $x = 61\%$, about $y = 17\%$ and $z = 22\%$, and since Schlueter, Jr. et al teach that antimony doped tin oxides are suitable for claimed purpose.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

September 18, 2002



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